

REMARKS

Claims 1-20 remain pending and at issue in the present application. Minor clarification amendments have been made to independent claims 1, 11 and 19-20 and a typographical error in claim 5 has been corrected. Support for all claim amendments appears in the SUMMARY OF THE DISCLOSURE section of the application, the specification at page 6, lines 16-24, the specification at page 9, lines 1-2, and Figs. 9-11 of the application as filed. No new matter is added thereby.

The Office rejects claims 1-20 under 35 USC §112, second paragraph, as allegedly being indefinite for reciting the phrase “proximally remote.” In response, independent claims 1, 11, 19, and 20 have been amended to remove this language, thereby traversing this rejection.

Turning to the rejections based on the prior art, the Office has rejected every claim as allegedly being anticipated by U.S. Patent No. 5,634,928 (“Fischell”). However, applicant respectfully submits that this rejection fails to meet the standard of MPEP § 2131, which recites:

[t]o anticipate a claim, the reference must teach every element of the claim.
“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Citing, Verdegall Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As shown below, Fischell fails to include every element of each pending independent claim and therefore the anticipation rejection of claims 1-20 is improper and must be withdrawn.

In its rejection, the Office states that the Fischell tube 13 is the equivalent of the claimed “inner shaft.” The Office then equates the Fischell tube 24 with the claims “outer shaft” and the Fischell member 11 with the claimed “rigid inner member.”

However, each independent claim requires the inner rigid member to be “rigidly coupled to” the inner shaft. This structural relationship enables a rigid coupling between the catheter 100, the rigid inner member 20 and the inner shaft 18 which in turn enables the outer shaft 16 to be retracted with respect to the inner shaft 18 and catheter 100 (see Figs. 10-11).

Retraction of the outer shaft 16 results in retraction of the outer sheath 96 with respect to the catheter 100, which is held in place by the rigid relationship between the inner shaft 18 and inner member 20.

Fischell fails to disclose this relationship. The Fischell tube 13 is not rigidly coupled to the Fischell tube 11. Instead, the Fischell tube 13 is connected to the balloon 16, which in turn is connected to the member 11. The balloon 16 is inflatable and therefore stretchable by its very nature. The elastic, stretchable connection the balloon 16 provides between the Fischell tube 13 and tube 11 is not a rigid coupling as recited in each independent claim.

Fischell also fails to teach or suggest the relationship between the inner and outer shafts as recited in the pending independent claims. Each claim requires the inner shaft to have distal end that is disposed proximally to the distal end of the outer shaft. Each claim further recites that the outer shaft has a first position, in which the distal end of the inner shaft is relatively farther from the distal end of the outer shaft, and a second position, in which the distal end of the inner shaft is relatively nearer to the distal end of the outer shaft. Fischell does not teach this relationship. Instead, the inner tube 13 of Fischell has a distal end that is *always* disposed distally with respect to the distal end of the tube 24. See Fig. 1 of Fischell. Thus, for this additional reason, the anticipation rejection of claims 1-20 must be withdrawn.

Finally, Fischell teaches nothing about the use of an inner shaft disposed within an outer shaft and the use of that outer shaft to retract a sheath. Fischell only teaches the use of a pusher tube 24, not a retraction tube. The Fischell device is not capable of retraction and no modification of the Fischell device would render it useful for retracting a sheath from a stent. Essentially, Fischell is irrelevant to the problem of safely retracting a sheath from a stent during an intravascular procedure.

The anticipation rejection does not meet the standard of MPEP § 2131, is improper and must be withdrawn.

Appl. No. 10/670,405
Resp. dated March 7, 2006
Reply to Office action of Jan. 9, 2006

CONCLUSION

It is submitted that the present application is in good and proper form for allowance.
A favorable action on the part of the Examiner is respectfully solicited.

If, in the opinion of the Examiner a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

The Patent Office is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-3629.

Dated: March 7, 2006

Respectfully submitted,

By 

Brent E. Matthias

Registration No.: 41,974
MILLER, MATTHIAS & HULL
One North Franklin Street
Suite 2350
Chicago, IL 60606
(312) 977-9902
Attorney for Applicant